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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,321	06/27/2001	Sergey N. Razumov	59036-022	3651
7590	02/08/2005		EXAMINER	
McDERMOTT, WILL & EMERY 600 13Th Street, N.W. Washington, DC 20005-3096			O CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/891,321

Applicant(s)

Razumov

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on August 6, 2004 (RCE) and November 17, 2004 (Election).

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) 1-13 and 27-30 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 14-26 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on October 18, 2001 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the Office action mailed May 6, 2004 has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 6, 2004 has been entered.

### ***Preliminary Remarks***

2. This Office action responds to the amendment and arguments filed by applicant on August 6, 2004 in reply to the Office action mailed May 6, 2004, and, to the election filed by applicant on November 17, 2004 in reply to the Office action mailed October 20, 2004.

3. The amendment of claims 1, 14, and 27 by applicant in the reply filed August 6, 2004 is hereby acknowledged.

### ***Election/Restriction***

4. Applicant's election without traverse of the invention of Group II, claims 14-26, in the reply filed November 17, 2004 is hereby acknowledged.

5. Claims 1-13 and 27-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed November 17, 2004.

***Claim Rejections - 35 USC § 101***

6. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 14-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 14-26 are drawn to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea without producing any “useful, concrete, and tangible result.” *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

Moreover, current Office practice is to reject as non-statutory under § 101, method claims such as claims 14-26 that fail to *require* the use of any particular technology (e.g., a computer) for failing to fall within the technological arts, thus failing to produce a useful, concrete, and tangible result. Claims must be tied to a technological art. To overcome this aspect of the rejection, a positive limitation in the body of the claim is required to recite the use of some technology, such as a computer *per se* or some other computer element that would

inherently and necessarily require a computer (e.g., a website), or else some other aspect or element of technology.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e)<sup>1</sup> the invention was described in-
  - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
  - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

9. Claims 14, 15, 17, 20, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey Jr. et al.

Bailey Jr. et al. disclose a method of selling goods, comprising the steps of: selecting human models representing categories of a pre-set classification of goods (styles and

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<sup>1</sup> The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) apply to the examination of this application as the application being examined was (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) as amended by the AIPA (post-AIPA 35 U.S.C. 102(e)).

sizes/physical characteristics); trying on the goods by the human models of the respective categories, at least one model being assigned to try on goods that belong to a category of the classification (inherent); evaluating the goods, which are tried on, to determine an evaluation mark indicating whether a particular item is suitable to the model that wears the item; obtaining individual characteristics of a customer to determine to which category in the pre-set classification the customer belongs; determining evaluation marks (inherent: for example, "good," "no-good," etc.) for the goods in the category to which the customer belongs; pre-selecting a group of items based on the evaluation marks; and, enabling the customer to access said group of items. See, in particular, the paragraph bridging pages 6 and 7, as well as the paragraph immediately thereafter.

Regarding claim 15, the method of Bailey Jr. et al. includes that the customer is enabled to watch video images depicting in motion the human models wearing the pre-selected items.

Regarding claim 17, the goods of Bailey Jr. et al. include clothes items.

Regarding claim 20, the pre-set classification of Bailey Jr. et al. takes into account body types of customers (sizes/physical characteristics).

Regarding claims 24 and 25, the method of Bailey Jr. et al. includes that the customer is enabled to access data on additional items associated with each of the pre-selected items (e.g., style variations, etc.), wherein the additional items are pre-selected when the goods are tried on by the human model (inherent).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 16, 18, 19, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey Jr. et al.

Bailey Jr. et al. disclose a method of selling goods, as applied above in the rejection of claims 14, 20, 24, and 25 under 35 U.S.C. 102(b), but Bailey Jr. et al. do not teach that a model or an expert makes the evaluation or selection. However, it is common in the art for evaluations to be made by experts or the person trying on clothes. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to employ a model or an expert to make the evaluation or selection, because such individuals would be qualified to make a correct evaluation/selection.

Regarding claim 22, Bailey Jr. et al. do not teach that the classification takes eye color into account. However, it is common in the art to recommend clothing based on a customer's eye color. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to employ the step of taking eye color into account for classification to select clothing that would complement a customer's eyes.

12. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey Jr. et al., in view of Weaver.

Bailey Jr. et al. disclose a method of selling goods, as applied above in the rejection of claims 14 and 20 under 35 U.S.C. 102(b), but Bailey Jr. et al. do not teach that a customer's hair color or skin tone are taken into account. However Weaver discloses a similar method, and the method of Weaver indeed teaches taking hair color (17) and skin tone (15) into account in making recommendations/selections. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Bailey Jr. et al. so as to take hair color and/or skin tone into account when recommending/selecting items, in accordance with the teachings of Weaver, in order to recommend/select items of clothing that would best complement a particular customer.

*Response to Arguments*

13. Applicant's arguments filed August 6, 2004 have been fully considered but they are not persuasive.

14. The arguments regarding the previous prior art rejections have been considered, but have been rendered moot by applicant's amendment, and the consequent new grounds of rejection.

***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to the disclosure.

16. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is **(703) 308-1113**.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(703) 308-5183**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

February 4, 2005



(2-4-05)

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627